

## **REMARKS**

This responds to the Office Action mailed on February 5, 2009.

### **Response to Specification Objection**

The Action objects to the specification as not providing antecedent basis for claim 12's recitation of "a machine-readable medium." In response, applicant directs the Examiner to the third full paragraph on page 6 of the original application, which states:

Server 116, representative of one or more servers, includes a processing unit 1161, and a memory 1162. Memory 1161, which can take the form of an electronic, magnetic, or optical computer- (or **machine-**) **readable medium**, includes one or more one or more search engines, and other modules and software, such as browser-compatible user-interface elements (UIEs) for receiving and fulfilling queries from clients. (Emphasis Added.)

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the objection.

### **Response to §101 Rejection**

Claim 13 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response, applicant submits respectfully that a browser-compatible user interfaces is itself a device or article of manufacture. However, to better demonstrate the "tangibleness" of the interface, applicant has amended claim 13 to specify that the user interface is implemented using at least one processor and memory.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the § 101 rejection of claim 13.

### **Response to §103 Rejection Based on Rivette**

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rivette (U.S. Patent No. 5,991,751).

In response, applicant submits respectfully that the rejection does not set forth a *prima facie* case of obviousness. First, the cited motivation of "improving management and leveraging of accumulated knowledge within law-firm document collections" has no connection with

modifying Rivette “to include the first database being a part of an information-management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information-management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories.” Indeed, one of skill lacking hindsight knowledge of the claimed invention, would not see providing a second database including case opinions, court documents, law review articles, statutory materials, or legislative histories as managing or leveraging the accumulated knowledge of the law-firm, when this information is at best supplemental to the accumulated patent knowledge and information within Rivette’s system.

Secondly, it does not appear that one of skill would be inclined it seems to break up Rivette’s singular enterprise system into multiple systems, with one being completely external to the other. Moreover, that the second databases are part of an online pay-for-access legal research service, as claim 3 requires, highlights the point.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the § 103 rejection of claims 1-14 based on Rivette.

Further, applicant submits respectfully that certain language in the Action indicates that the Examiner is regarding specified contents of the databases as intended uses of the databases rather than particular attributes of the databases. (See top of page 8 of the Action.) However, the claim languages affirmatively cites the contents of the databases not in the language of intended use, such as “for storing certain contents” or “to store certain contents,” but as actual affirmative contents or attributes of the databases. Accordingly, the recited content requirements are claimed in a manner capable of distinguishing the invention.

#### **Response to §103 Rejection Based on Rivette and Barney**

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Rivette in view of Barney (U.S. Patent 6,556,992).

In making the rejection, the Examiner concedes that Rivette lacks a teaching of “the first database being a part of an information-management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second

database being external to the information-management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories.” The Examiner then argues that Barney teaches the requisite first and second database at column 11, lines 1-67. For the first database the Examiner quotes “Such information might include prior art that was not cited in the patent, possible license terms, potential problems with the written description or claims of the patent, information about the inventors, information relating to sales of patented products prior to the filing date, legal opinions, related litigation, and any other information that might be relevant to the patent.” And for the second database the Examiner quotes: “Examples of indirect patent metrics included reported patent litigation results, published case opinions, patent licenses, marking of patented products, and the like.”

In response, applicant submits respectfully that nothing in the specific quotations nor in the entire cited passage nor in the entirety of Barney teaches that such information is provided in first and second separated databases or that even if they were in separate databases that the second database is outside or external to the system including the first database.

Plus, applicant found no teaching in Barney to provide the data used as basis for its scoring in direct response to user queries. As such, the proposed combination even if permissible fails to teach the requisite first and second databases.

In the Action, the Examiner states that “one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references,” citing *In re Keller*. In response, applicant submits respectfully that in *In re Keller*, the court decided that the affidavit of expert was insufficient to rebut obviousness because all it did was attack one of the references in a combination. In the present situation, applicant is not merely attacking the Barney reference, but pointing out that the feature Barney is cited as teaching is not in fact taught by Barney, and thus the proposed combination itself, even if permissible, does not meet all the requirements of the rejected claims. Thus, applicant’s argument is not a naked attack on Barney, but a demonstration that the proposed combination fails to yield the claimed invention because it doesn’t meet all the terms of the claims.

### **Reservation of Rights**

In the interest of clarity and brevity, applicant may not have equally addressed every assertion made in the Office Action; however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 349-9593 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

5 June 2009

By

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5<sup>th</sup> day of June, 2009.

Name

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Signature